

REMARKS

The Office Action mailed June 12, 2007 has been carefully reviewed. Claim 61 is added, Claims 2-3, 14, 17-22, 26, and 56 are cancelled and claims 1, 4, 36 and 54 are amended. Upon entry of this amendment, claims 1, 4-13, 15-16, 23-55 and 57-61 will be pending in this application.

**Drawing Objection**

Applicants traverse the drawing objection at page 2 of the Office Action. The drawings are asserted to be incorrect because reference characters 32 and 46 have both been used to designate a bottom surface. However, these characters refer to two different bottom surfaces. Character 32 refers to the bottom surface of housing 14 (see paragraph 30 of the application). Character 46 refers to the bottom surface of the mouthpiece interface 16 (see paragraph 33).

**Rejections under 35 U.S.C. § 102(b) and 103(a)**

**Claim 1**

Claim 1 is rejected as anticipated by Mault (U.S. Patent No. 6,468,222) and Gump (4,656,008). Claim 1 recites a breath testing device housing comprising: a base to be gripped by an operator and having a front edge and an opposite back edge; a display oriented on one of the edges and aligned with an operator's direct line of view while gripping said base; a mouthpiece interface for interfacing with a removable mouthpiece, said mouthpiece interface oriented with respect to said base such that when the operator stands in front of the subject and a subject blows into the mouthpiece, said display

is not in the direct line of view of the subject, and at least one actuator including a manual sample button located on the edge of said base opposite the display.

Claim 1, as amended, recites the substance of old claim 3 regarding a manual sample button. As indicated in the Office action, the subject matter of claim 3 is not found in either Mault or Gump. Accordingly, the rejection under § 102(b) must be withdrawn.

In addition, applicants have further clarified claim 1 by stating the position of the operator when the subject blows into the mouthpiece. In particular, the operator stands in front of a subject when the subject blows into the mouthpiece. The advantages of this position are discussed in paragraphs 9-10 and 44-45 of the application. Briefly, this position enables the operator to take the measurement while keeping his or her weapon distant from the subject. It also allows the operator to keep one hand on the device and one hand on his or her weapon.

With respect to the rejection of old claim 3 as obvious in view of Mault (6,468,222) and Mault (6,402,698), Applicants submit that the conclusion regarding obviousness is incorrect. The rejection concludes that the placement of the button is an obvious matter of design choice, based on the assumption that the placement "does not add any advantage to the operator."

In fact, the placement of the manual sample button is advantageous for the reasons described in the specification at paragraphs 44-47. As a quick summary, the end result of

this placement is that it allows for a complete one-handed use that is natural and intuitive whether using the left hand or the right hand to take a manual sample. (Paragraph 47).

The cited prior art does not show or suggest the claimed placement, or the advantages of this placement. As admitted in the rejection, neither Mault reference shows a manual sample button in the claimed position. Advantageously, the claimed design is built for both left and right hand use, in contrast to the prior art. Applicants also note that MPEP 2144.01, cited in the rejection of claim 3, relates to implicit disclosures. There is no implicit disclosure in either reference that would support the rejection. In view of these advantages and the lack of a teaching or common knowledge in the art, the obviousness rejection must be withdrawn.

For the above reasons, claim 1 is believed to be patentable over Mault and Gump. Claims 4-12 depend from independent Claim 1 and are also patentable over the cited art.

### **Claim 13**

Claim 13 stands rejected as anticipated by Lutz (4,274,425). Claim 13, as amended, recites the substance of old claim 14 regarding a discard breath outlet oriented such that discard breath is not directed at an operator of the testing device. In addition, claim 13 recites that the discard breath is not directed into the device. As indicated in the Office action, the subject matter of old claim 14 is

not disclosed in Lutz. Accordingly, the rejection of claim 13 under § 102(b) must be withdrawn.

The subject matter of old claim 14 was rejected as obvious in view of Lutz and Wolf (5,291,898). The Office action asserts that Wolf "teaches that the mouthpiece comprises a discard breath outlet (exhaust 26 & port 11, presented as 13 in Fig. 2) oriented such that discard breath is not directed at an operator of the breath-testing device during testing." Applicants do not find such a disclosure in Wolf. Wolf describes reference character 13 as follows at paragraph 2 of the Detailed Description: "In its lower half 7, near the far end of the exhaust manifold section 26, is an exhaust port 11, surrounded by a circle of teeth or merlons 13, forming a crenelated wall to prevent accidental obstruction of the port 11." Applicants cannot find a teaching or a suggestion in Wolf that this manifold section 26 or the merlons 13 serve to direct discard breath in the claimed manner. Moreover, Wolf does not show or suggest that discard breath is not directed into the device. Thus, claim 13, as amended, is patentable over Lutz and Wolf.

To further distinguish over the prior art, claim 13 now recites a display. The discard breath outlet ensures that discard breath is not directed at an operator of the breath testing device during testing when the operator views the display.

For all the above reasons, claim 13 is patentable over the art of record. Claims 15-16 depend from independent Claim 13 and are also patentable over the art.

**Claim 23**

Claim 23 is rejected as anticipated by Mault and Gump. Claim 23, as amended, recites that the mouthpiece interface includes a stop for positively locating the mouthpiece, the mouthpiece being placed against the stop in a testing position.

Because neither reference shows this feature in combination with the other features of claim 23, the rejection must be withdrawn. Claims 24-25 and 27-35 depend from claim 23 and are also patentable over Mault and Gump.

**Claim 36**

Claim 36 is rejected as anticipated by Mault. Claim 36, as amended, recites a breath tester housing assembly comprising, among other things, a mouthpiece configured to extend obliquely from the housing. Further it clarifies that the operator stands in front of the subject in a sideways stance.

Mault does not show a mouthpiece configured to extend obliquely from its housing. Rather, the mouthpiece of Mault extends generally perpendicular to its housing.

The claimed mouthpiece is advantageous because it helps to ensure that the operator can see the display while testing is being done. As recited in the claim, the operator stands in front of the subject in a sideways stance and can view the display. In this way, the operator can both see the display and monitor the actions of the subject.

In view of the fact that Mault does not show each element of claim 36, the rejection under § 102(b) must be withdrawn. The rejection of claims 37-46, which depend from claim 36, must also be withdrawn.

**Claim 47**

Claim 47 is directed to a breath testing device mouthpiece having a cross-sectional shape being one of: a D-shaped cross-sectional shape and a V-shaped cross-sectional shape.

Claim 47 is rejected as obvious in view of Hirsch (4,202,353). As admitted in the Office action, Hirsch does not disclose a mouthpiece having a D-shaped or V-shaped cross-sectional shape. The rejection asserts that such shape is a matter relating to ornamentation only, and has no mechanical function. However, this assertion is factually incorrect. As disclosed in the specification at paragraphs 43 and 55, the claimed cross-sectional shape helps to orient the mouthpiece during insertion into the interface, among other functions. This allows the operator to have a "feel" for how the mouthpiece should go into interface. Accordingly, there is a mechanical function to the claimed shapes, and the rejection must be withdrawn.

Claims 48-53 depend from claim 47 and are submitted as patentable for the same reasons as claim 47.

**Claim 54**

Claim 54 is directed to a mouthpiece for a breath testing device having, among other features, at least one port for

channeling discard breath air from the mouthpiece during testing such that discard breath is not directed towards an operator of the breath testing device during testing. This feature of amended claim 54 is incorporated from old claim 56, and is not shown by Lutz. Moreover, this feature is not obvious in view of Lutz and Wolf for the reasons set forth above respect to claim 13.

Claim 54, as well as dependent claims 55 and 57-60, are believed to be patentable over the art.

**New Claim 61**

New claim 61 is believed patentable over the art of record.

**Response to Statutory (35 U.S.C. 101) Double Patenting Rejection**

Claims 1-5, 9, 12-27, 29, 34-37, 41, 43 and 45-60 have been rejected on the ground of statutory double patenting over claims 1-29 of U.S. Patent Application No. 11/089,655.

MPEP §804 states that a reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a "halogen"

substituent is not identical to or substantively the same as a claim reciting the same compound except having a "chlorine" substituent in place of the halogen because "halogen" is broader than "chlorine." On the other hand, claims may be differently worded and still define the same invention. Thus, a claim reciting a widget having a length of "36 inches" defines the same invention as a claim reciting the same widget having a length of "3 feet."

In this case, claim 1 of the '655 application recites a mouthpiece ... comprising an increased flexibility section. The embodiments of the present invention do not fall within the scope of claim 1 of the '655 application because none of the embodiments include this increased flexibility section. Accordingly, the provisional rejection must be withdrawn.

In the event the Office maintains its double patenting rejections of the, applicants request citation of the specific teaching in the claims of U.S. Patent Application No. 11/089,655 that the Office believes corresponds to each and every element recited in claims 7-9.

As a result, reconsideration and withdrawal of the Office's double patenting rejection of claims 7-9 is respectfully requested.



**Conclusion**

In view of the foregoing remarks and amendments, all the claims now in this application are believed to be in condition for allowance. Applicants respectfully request reconsideration and favorable action. The undersigned requests a telephone call from the Examiner if this might expedite allowance of the application.

The Commissioner is hereby authorized to charge the fee of \$ 120.00 for a one-month extension and any additional fees in connection with this Amendment A to Deposit Account Number 012384 in the name of ARMSTRONG TEASDALE LLP.

Respectfully Submitted,

/Michael G. Munsell/  
Michael G. Munsell, Reg. No. 43,820  
ARMSTRONG TEASDALE LLP  
Suite 2600  
One Metropolitan Square  
St. Louis, Missouri 63102-2740  
(314) 621-5070

MGM/ts  
Via EFS